

**REMARKS**

Claims 1, 3-7 and 9-28 are now present in connection with the present application, with claims 1, 12, 13, 21 and 25 being independent, and with dependent claims 27 and 28 being added.

**Allowable Subject Matter**

Initially, Applicants wish to thank the Examiner for the indication that claim 13 would be allowable if a minor objection to the claim were corrected, and for the indication that claims 16-20 and 23 contain allowable subject matter and would be allowed if rewritten into independent form. By the present Amendment, the objection to claim 13 has been corrected. However, with regard to the remaining claims, Applicants believe that each of independent claims 1, 12, 21 and 25 are allowable in their current format and thus claim 16-20 and 23 have not been written into independent form at this time.

**New Prior Art and Compact Prosecution**

Applicants do not believe that they have been provided with proper compact prosecution to which they are entitled with regard to a U.S. patent application. Although a new law firm has now been retained to handle prosecution in connection with the present application, a review of the file indicates that an Appeal Brief has been filed in connection with the present application, along with two continuation applications.

Despite this advanced amount of prosecution, the Examiner still conducted a further search in connection with the present application discovering many patents issued from the 1930's, 1960's and 1990's, and has used many of these patents in rejections to the claims in connection with the present application. Despite the fact that the claims are now slightly narrower than originally filed, the Examiner still went out and uncovered prior art which should have been uncovered during the initial search of the claims of the application (namely, the prior art was not prior art that was recently issued by the U.S. Patent and Trademark Office and was thus otherwise unavailable to the Examiner during the earlier aspects of patent prosecution). Further, not only have rejections been made, but multiple rejections of the same claim have been made (the Examiner should make only the best possible rejection of each claim).

Such piecemeal prosecution creates undue delays in the process which has, especially in connection with the present application, increased the amount of expense necessary to prosecute the claims of the present application. As Applicants will hereby address each of the Examiner's rejections and have made, in some instances, amendments to expedite prosecution in the present application, an early indication of the allowability of each of the claims in connection with the present application is earnestly solicited.

### **Claim Objections**

The Examiner has objected to the claims because of minor informalities. Although these minor informalities do not render the claims

indefinite in any way, Applicants have amended the claims as requested by the Examiner in an effort to expedite prosecution in connection with the present application. Again, these amendments are non-narrowing amendments which have not been made for any reason relating to patentability.

**Claim Rejections under 35 U.S.C. §112**

The Examiner has rejected claims 9, 14 and 24 under 35 U.S.C. §112, second paragraph. This rejection is respectfully traversed.

Initially, with regard to the Examiner's objections and rejections, Applicants note that the present claims have been pending throughout a lengthy prosecution in connection with the present application, wherein various phrases objected to or rejected by the Examiner are phrases which have been present since the claims were originally filed. Thus, these rejections are respectfully traversed.

With regard to claim 9, the Examiner objects to the term "softer" as being a relative term. The Examiner alleges that the use of such a relative term renders the claim indefinite. Applicants respectfully traverse this assertion and further note that the term "softer" has been present in claim 9 since originally filed and was never rejected to by the Examiner. As the Examiner issued many Office Actions in connection with the present application, the Examiner clearly recognized the meaning of "softer" in claim 9 and thus the claim was never indefinite.

MPEP §2173.02 sets forth the requirement for definiteness, namely whether the claim meets the threshold requirements of clarity and precision,

not whether more suitable language or modes of expression are available. As stated in MPEP §2173.02, when the Examiner is satisfied the patentable subject matter as disclosed, he or she should allow claims which define the patentable subject matter with a reasonable degree of particularity or distinctness. As stated in the aforementioned section of the MPEP, some latitude in the expression of the term should be permitted, even though the claim language is not as precise as the Examiner might desire.

MPEP §2173.05(b) discusses the use of relative terminology. As stated in this section, the fact that the claim language, including terms of degree, may not be precise, does not automatically render the claim indefinite under 35 U.S.C. §112, second paragraph. Acceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed, in light of the Specification. Most of the terms objected to in this section of the MPEP deal with relative terms used in a non-relative manner. This is not the case with claim 9.

First, when looking at the claims, the term “softer” is not used in an indefinite manner, but is instead used in a relative manner with respect to two other terms. The claim states that the clamping element has been made from softer material than the carrier. Thus, one claim term is used relative to the other.

When viewing the Specification, one example of a purpose of using such softer material is that it prevents damaging growing material as stated on page 7, line 27 to page 8, line 2 of the present application. As long as a relative term includes a relationship between two elements, the claim should

not be considered to be indefinite. Accordingly, withdrawal of the Examiner's rejection of claim 9 is respectfully requested.

Regarding the rejection of claim 14, and dependent claim 24, Applicants have reviewed the claims and have amended the dependency of claim 14 so as to depend upon claim 13, and not claim 12. Further, Applicants have changed the phrase "wall" to --walls-- in claim 14. As the claim now has proper antecedent basis in independent claim 13, withdrawal of the Examiner's rejection is respectfully requested.

#### **Prior Art Rejections**

Before addressing the individual rejections raised by the Examiner, Applicants note that it is the Examiner's burden to provide the single best prior art rejection, and not a litany of prior art rejections. In connection with the present application, the Examiner has rejected independent claim 1 under 35 U.S.C. §102, and has further rejected independent claim 1 on four separate occasions under 35 U.S.C. §103. These rejections are not justified for the reasons indicated hereafter and thus withdrawal of each of the rejections is respectfully requested. However, if a single rejection is to remain, the Examiner is requested to pick the best rejection and apply only this rejection to the claims so that prosecution can be expedited.

#### **Claim Rejections under 35 U.S.C. §102**

The Examiner has rejected claims 12, 14, 15, 21 and 22 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 2,102,479 to Newfield (the Newfield '479 patent). This rejection is respectfully traversed.

Initially, with regard to the Newfield '479 patent, the Examiner alleges that the two elements 7, 8 in Fig. 3 of the Newfield '479 patent are the parts of the clamping element as claimed, which each take substantially the form of a semi-cylindrical surface. Applicants respectfully traversed this aspect of the Examiner's rejection.

Initially, Applicants note that elements 7, 8 of the Newfield '479 patent are not semi-cylindrical. In the Newfield '479 patent, wire disclosed for tobacco which is bent into loops 8, to project tobacco leaves where they are being thrust in between spring arm 7 (see right column, lines 13-19). Such a loop is clearly not "semi-cylindrical".

In an effort to expedite prosecution and to clarify the distinction over the Newfield '479 patent, each of independent claims 12 and 21 have been amended to clarify that the parts of the clamping element each take substantially the form of "a semi-cylindrical **sleeve**". Such a semi-cylindrical sleeve is supported throughout the present application, referring to Figs. 1-6 and 9 for example. By clarifying that each of these parts are in the form of semi-cylindrical **sleeves** in each of claims 12 and 21 of the present application, such claims should clearly distinguish from the loops 8 in the Newfield '479 patent which are **clearly not sleeves (nor semi-cylindrical)**, connected on one side by way of branches 6 and 15 as shown in Fig. 1.

Still further, with regard to claim 12, the loops 8 in Newfield '479 patent are connected on one side by branches 6 and 15 without any gap, and thus fail to teach or suggest that the parts of the clamping elements are

separated on either side by a narrow gap as set forth in claim 12 of the present application.

For at least such reasons, Applicants respectfully submit that each of independent claims 12 and 21, and all claim dependent thereon, is patentable over the Newfield '479 patent. Accordingly, withdrawal of the Examiner's rejection is respectfully requested.

The Examiner has rejected claims 1, 3-6, 25 and 26 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,339,967 to Valiulis (the Valiulis '967 patent). This rejection is respectfully traversed.

Initially, with regard to the Valiulis '967 patent, the Examiner focuses on the language "adapted to" as used in independent claims 1 and 25 for example. While it is clear that the claims state that the clamping elements are adapted to clamp a plant cutting and thus are capable of such a function, **the function is further clarified in the claims** by the statement in the claims that "wherein the clamping elements are fixed to the carrier such that plant cuttings clamped in the clamping elements extend substantially parallel to each other". Thus, not only are the claims "capable of" clamping a plant cutting, but they further must be of such construction that when they do clamp the plant cuttings, the clamped plant cuttings extend substantially parallel to each other. **Such limitations of the claim cannot be ignored.** As the Examiner has been ignoring these limitations, withdrawal of the Examiner's rejection is respectfully requested.

Further, with regard to claim 1 of the present application, the Valiulis '967 patent also does not teach or suggest a carrier which is **substantially flexible or** divided into two substantially rigid **pieces which**

**are coupled in a mutually flexible manner.** Again, such a limitation is not addressed by the Examiner and thus the rejections of claim 1 and various claims dependent thereon should be withdrawn. The supporting of portion 19 of the Valiulis '967 patent clearly fails to teach or suggest such a claim limitation.

To further clarify the distinctions with regard to claim 25 of the present application, and to further expedite prosecution of the present application, claim 25 has been amended to indicate that the carrier is substantially flexible or divided into two substantially rigid pieces which are coupled in a mutually flexible manner. As stated above, such a feature is not taught or suggested by the Valiulis '967 patent. Accordingly, allowance of claim 25 and dependent claim 26 are respectfully requested.

**Prior Art Rejections under 35 U.S.C. §103**

The Examiner has rejected claims 1, 3-6, 9 and 11 under 35 U.S.C. §103 as being unpatentable over the Newfield '479 patent in view of U.S. Patent No. 5,762,212 to Pomerantz (the Pomerantz '212 patent). This rejection is respectfully traversed.

As admitted by the Examiner, the Newfield '479 patent fails to teach or suggest at least a carrier which is either substantially flexible or divided into substantially rich pieces which are coupled in a mutually flexible manner, as set forth in claim 1 of the present application for example. The Examiner admits such a deficiency in paragraph 3 of page 6 of the Examiner's Office Action.



The Examiner attempts to makeup for such a deficiency by utilizing the Pomerantz '212 patent wherein it states in column 3, line 20 and column 4, lines 36-37 that a merchandiser 10 can be made of flexible plastic. Applicants submit that even assuming *arguendo* that the references could be combined, the combined teachings would still fail to teach or suggest at least the clamping elements as claimed.

The Examiner focuses on the language “adapted to” as used in independent claim 1 for example. While it is clear that the claims state that the clamping elements are adapted to clamp a plant cutting and thus are capable of such a function, **the function is further clarified in the claims** by the statement in the claims that “wherein the clamping elements are fixed to the carrier such that plant cuttings clamped in the clamping elements extend substantially parallel to each other”. Thus, not only are the claims “capable of” clamping a plant cutting, but they further must be of such construction that when they do clamp the plant cuttings, the clamped plant cuttings extend substantially parallel to each other. **Such limitations of the claim cannot be ignored.** As the Examiner has been ignoring these limitations, withdrawal of the Examiner’s rejection is respectfully requested.

Further, while it may be true that the merchandiser 10 can be made of flexible plastic in the Pomerantz '212 patent, Applicants respectfully submit that the Examiner has not established a *prima facie* case of obviousness and that it would be obvious for one of ordinary skill in the art to **combine** the teachings of the Newfield '479 patent with those of the Pomerantz '212 patent to make the tobacco hangers of the Newfield '479 patent flexible. This will be explained as follows.

Applicants further submit that the Examiner has not supplied **evidence** of the necessary motivation needed to lead one of ordinary skill in the art to combine the teachings of the Newfield '479 patent with those of the Pomerantz '212 patent. Accordingly, absent such motivation, a *prima facie* case of obviousness under 35 U.S.C. §103(a) has not been established and the rejection must be withdrawn.

Applicants direct the Examiner's attention to two recent cases decided by the Court of Appeals for the Federal Circuit (CAFC), In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed.Cir. 1999) and In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed.Cir. 2000). Both of these cases set forth very rigorous requirements for establishing a *prima facie* case of obviousness under 35 U.S.C. §103(a).

To establish obviousness based on a combination of elements disclosed in the prior art, there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the Applicants. The motivation suggestion or teaching may come explicitly from one of the following:

- (a) the statements in the prior art (patents themselves)
- (b) the knowledge of one of ordinary skill art, or in some cases,
- (c) the nature of the problem to be solved.

See Dembiczak 50 USPQ at 1614 (Fed.Cir. 1999).

In order to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a), the Examiner must provide particular findings as to why the two pieces of prior art are combinable. See Dembiczak 50 USPQ2d at 1617.

**Broad conclusory statements standing alone are not "evidence".**

The alleged motivation, for combining the teachings of the Newfield '479 patent with those of the Pomerantz '212 patent to the claims, asserted by the Examiner is that the "...modification is merely the selection of a known material for intended use selected for its light weight properties to reduce shipping/transporting costs and its ability to withstand environmental conditions such as rain without rapid decay." Such alleged motivation **is not believed to be present in any of the references** and has merely been alleged by the Examiner based upon Applicants invention, in hindsight. Further, even if it were present in the Pomerantz '212 patent, it has nothing to do with motivating one of ordinary skill to do anything to the tobacco hangers of the Newfield '479 patent, let alone make plastic. At best, it would only suggest to make display strip merchandizers plastic, **not tobacco hooks**. Such use of hindsight is clearly improper.

Thus, the alleged motivation as cited by the Examiner in the outstanding Office Action, makes use of impermissible hindsight reconstruction. The Examiner has viewed the present application, selected a first piece of art, and then searched other prior art for the missing elements without identifying or discussing **any specific evidence of motivation to combine**, other than providing conclusory statements regarding the knowledge in the art, motivation and obviousness.

First of all, the Pomerantz '212 patent is not related to anything to do with a holder for transporting plant cuttings, let alone any type of tobacco hanger. Further, the Pomerantz '212 patent is silent about the purpose or advantage of using flexible plastic material for its merchandiser. Thus, the Pomerantz '212 patent, fails to provide any evidence of motivation as to why

one of ordinary skill in the art would be led to modify the teachings of the Newfield '479 patent, to make the tobacco carrier substantially flexible based upon the teachings of the Pomerantz '212 patent.

The only advantage is an advantage of Applicants' disclosed in the specification, namely to reduce the space taken up by the holder during storage or transportation as discussed on page 2, lines 19-28 of the present application, which again, if used, is an impermissible use of hind sight. The Examiner alleges that it would be obvious to modify the teachings since the modification is merely the selection of a known material for an intended use selected for slight weight properties to reduce shipping/transportation costs and its ability to withstand environmental conditions such as rain without rapid decay, but such an alleged motivation is not based and any type of evidence is merely speculation introduced by the Examiner.

Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight. Dembiczak, 50 USPQ2d at 1617. Accordingly, Applicants respectfully submit that the claims are allowable for at least this additional reason.

Furthermore, the Examiner has not provided the **requisite evidence** to support his allegation that there is motivation to combine the teachings of the Newfield '479 patent with those of the Pomerantz '212 patent, so as to render obvious that which Applicants have described. The Examiner has not provided any showing of a suggestion, teaching or motivation to combine the prior art references to reject the claims in the present application, which

is an essential component of an obviousness holding. The Examiner must explain the **reasons why** one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious (In re Fritch, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) the examiner can satisfy the burden of showing obviousness of the combination "only by showing **some objective teaching in the prior art or that knowledge generally available** to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references"). Thus, the Examiner has not adequately provided a proper combination of the teachings of the Newfield '479 patent and those of the Pomerantz '212 patent to render the claims obvious.

Relying on common knowledge or common sense of a person of ordinary skill in the art without any specific hint or suggestion of this in a particular reference is not a proper standard for reaching the conclusion of obviousness. See *In re Sang Lee*, 61 USPQ 2d 1430 (Fed. Cir. 2002).

Further, relying on obvious design choice as a reason for combining teachings of the various references is again not the proper standard for obviousness. ***If the Examiner is relying on personal knowledge to support a finding of what is known in the art, the Examiner must provide an Affidavit or Declaration*** setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2) and MPEP 2144.03(c). Accordingly, Applicants respectfully challenge the Examiner's alleged motivation and respectfully require the Examiner to withdraw the rejection or provide an Affidavit or Declaration as set forth above if the rejection is to be maintained.

Thus, withdrawal of the outstanding rejection is respectfully requested.

Accordingly, withdrawal of the rejection of claim 1 and all claims dependent thereon is respectfully requested.

The Examiner has further rejected claims 1, 3, 4, 6, 9, 10 and 24 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,779,066 to Drower (the Drower '066 patent) in view of the Pomerantz '212 patent. This rejection is respectfully traversed.

As admitted by the Examiner, the Drower '066 patent, somewhat similar to the Newfield '479 patent, is silent about the carrier being flexible. Further, the Examiner focuses on the language "adapted to" as used in independent claim 1 for example. While it is clear that the claims state that the clamping elements are adapted to clamp a plant cutting and thus are capable of such a function, **the function is further clarified in the claims** by the statement in the claims that "wherein the clamping elements are fixed to the carrier such that plant cuttings clamped in the clamping elements extend substantially parallel to each other". Thus, not only are the claims "capable of" clamping a plant cutting, but they further must be of such construction that when they do clamp the plant cuttings, the clamped plant cuttings extend substantially parallel to each other. **Such limitations of the claim cannot be ignored.** As the Examiner has been ignoring these limitations, withdrawal of the Examiner's rejection is respectfully requested.

Somewhat similar to the situation emphasized above, the Examiner attempts to combine the teachings of the Pomerantz '212 patent with those of another reference, the Drower '066 patent. As the Drower '066

patent does not provide any additional motivation for combining its teachings with those of the Pomerantz '212 patent, this rejection is respectfully traversed for reasons somewhat similar to those set forth above regarding the alleged combination of the Newfield '479 patent and the Pomerantz '212 patent. Accordingly, withdrawal of this rejection is respectfully requested.

Finally, the Examiner has included an additional rejection, rejecting each of claims 1, 3-5, 7, 9, 11, 12, 14, 21 and 24 under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 4,880,133 to Cullinane (the Cullinane '133 patent) in view of U.S. Patent No. 3,207,014 to Lindblom (the Lindblom '014 patent). This rejection is respectfully traversed.

Regarding the Cullinane '133 patent, contrary to the Examiner's allegations, the Cullinane '133 patent does not teach a series of clamping elements fixed to the carrier. Even if, for example, the church pew 10 is viewed as a carrier, the clamping element (bracket 11, column 2, lines 63-65) is not fixed to the carrier (it is instead a reasonably clamped to carrier 10 as discussed in column 3, lines 2-5). Further, the carrier (pew 10 of the Cullinane '133 patent) is not part of the holder, contrary to that set forth in claim 1 for example wherein the carrier and clamping elements are both comprised in the holder.

Furthermore, even if the teachings of the Lindblom '014 patent were combined with those of the Cullinane '133 patent, which Applicants do not admit for reasons similar to those emphasized above, the alleged combination would still fail to teach or suggest clamping elements which are fixed to at least one carrier as set forth in claim 1 of the present application.

The teachings of the Lindblom '014 patent would fail to makeup for at least this deficiency of the Cullinane '133 patent, even assuming *arguendo* that they could be combined (which Applicants do not admit for reasons similar to those set forth above).

Finally, the carrier (church pew 12) of the Lindblom '014 patent is not coupled in a mutually flexible manner, contrary to that set forth in claim 1 of the present application. The ribbons 23 (Figs. 1 and 4) are fastened to the decorative item holders 13 which are reasonably clamped to the end members 11 of the church pew 12. The fastening of the ribbon 23 between the holders 13 does not introduce a mutual flexibility between the ridged pieces (end members 11 of the church pew 12) of the carrier. Hence, even assuming *arguendo* that the references could be combined which Applicants do not admit, the alleged combination of the Cullinane '133 patent and the Lindblom '014 patent would not render the teachings of claim 1 obvious.

With regard to remaining independent claims 12 and 21, these claims are allowable for at least one of the reasons previously set forth regarding independent claim 1. Accordingly, withdrawal of the rejection of these claims is also respectfully requested.

### **New Claims**

New claims 27 and 28 have been added to even further define over the references of record, taken either singly or in combination. Specifically, none of the references teach or suggest at least a carrier that is substantially flexible so as to reduce space taken up by the holder during storage or transportation.



**CONCLUSION**

Accordingly, in view of the amendments and remarks, reconsideration of all objections and rejections and allowance of each of claims 1, 3-7 and 9-28 in connection with the present application is earnestly solicited.

If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the telephone number listed below.

Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicants hereby petition for a one (1) month extension of time for filing a reply to the outstanding Office Action and submit the required \$120.00 extension fee herewith.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

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